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### PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number: **RSW920010130US1**

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on Oct. 19, 2005

Signature Dell Whitton

Typed or printed name Dell Whitton

Application Number: **09/938,966**

Filed : **Aug. 24, 2001**

First Named Inventor: **Aupperle et al.**

Art Unit **2123**

Examiner **Stevens, Thomas**

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

☒ attorney or agent of record. 48,504  
Registration number

☐ attorney or agent acting under 37 CFR 1.34.  
Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

Theodore D. Fay III  
Signature  
Typed or printed name

972-385-8777  
Telephone number

October 19, 2005  
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

☐ \*Total of \_\_\_\_\_ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application: **Aupperle et al.**

Serial No.: **09/938,966**

Filed: **August 24, 2001**

For: **Apparatus and Method for  
Determining Compatibility of Web  
Sites with Designated Requirements  
Based on Functional Characteristics  
of the Web Sites**

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Group Art Unit: **2123**

Examiner: **Stevens, Thomas H.**

Attorney Docket No.: **RSW920010130US1**

**Certificate of Mailing Under 37 C.F.R. § 1.8(a)**

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By: \_\_\_\_\_

*Dell Whitton*  
Dell Whitton

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**REASONS IN SUPPORT OF APPLICANTS' PRE-APPEAL  
BRIEF REQUEST FOR REVIEW**

Sir:

This document is submitted in support of the Pre-Appeal Brief Request for Review filed concurrently with a Notice of Appeal in compliance with 37 C.F.R. 41.31 and with the rules set out in the OG of July 12, 2005 for the New Appeal Brief Conference Pilot Program.

No fee or extension of time is believed due for this request. However, if any fee or extension of time for this request is required, Applicants request that this be considered a petition therefor. The Commissioner is hereby authorized to charge any additional fee, which may be required, or credit any refund, to IBM Corporation Deposit Account No. 09-0461.

## REMARKS

Applicants hereby request a Pre-Appeal Brief Review (hereinafter "Request") of the claims presented as of the Final Office Action mailed August 5, 2005. The Request is provided herewith in accordance with the rules set out in the OG dated July 12, 2005.

A pre-appeal brief review is needed because the rejections are clearly in error and will be overturned on appeal. The examiner rejects claims 1-32 and 34-42 under 35 U.S.C. § 102(e) as anticipated by *Welter* et al., Testing Web Sites, U.S. Patent 6,631,408 (Oct. 7, 2003).

Claim 1 recites:

A computer implemented method of identifying web sites, comprising:  
*identifying at least one functional characteristic to be tested;*  
retrieving content for a web site;  
*testing the content of the web site for a presence of the at least one functional characteristic;* and  
storing results of the testing of the content of the web site.

*Welter* does not anticipate claim 1 because *Welter* clearly does not show identifying and testing for the presence of "functional characteristics," as claimed. The examiner asserts otherwise, citing various portions of *Welter*. As shown in the previous response to office action, the examiner's assertions regarding what *Welter* shows vis-à-vis claim 1 are incorrect.

In the final office action of August 5, 2005, the examiner mischaracterized the definition of "functional characteristics" and mischaracterized *Welter* vis-à-vis claim 1. The term "functional characteristic" as defined in the specification and as used in the claims is not disclosed nor suggested by *Welter*.

Applicants are entitled to be their own lexicographers such that claim terms are defined by the specification, see MPEP § 2111.01 and *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994). Applicants have clearly defined the term "functional characteristic" as follows:

By "functional characteristics" what is meant is the functions supported by the web site that require functions to be enabled by user client devices in order to output the content of the web site on the client device and/or receive input from the client devices directed to the web site. These functions may be provided through

the computer code of the web site, plugin modules used by the web site, third party web sites, applications resident on client devices, and the like.

Specification, p. 10, ll. 11-20.

The examiner states that “the phrase ‘functional characteristic’ apparently, has several loosely defined terms.” However, the examiner’s assertion is clearly incorrect. The specification clearly defines what is meant by the term “functional characteristic.” The term means “the functions supported by the web site that *require functions to be enabled by user client devices in order to output the content of the web site on the client device and/or receive input from the client devices directed to the web site.*” Given that the term “functional characteristic” has been clearly defined in the specification, this definition is imparted to the term as it is used in the claim. *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994).

Welter simply does not show or suggest identifying or testing functional characteristics in the manner claimed. The examiner asserts otherwise, stating that a functional characteristic may be a source code of a web browser (e.g. HTML) for a web page. The examiner appears to support this assertion with the statement that “Examiner refutes this statement as inherent considering the nature of detail and preciseness of program code to properly execute a plurality of events.” However, a source code of a web browser for a web page is not a functional characteristic. A source code merely provides the language for carrying out an instruction. A source code for a web browser is not, itself, “*the functions supported by the web site that require functions to be enabled by user client devices in order to output the content of the web site on the client device and/or receive input from the client devices directed to the web site.*” The examiner’s statement regarding inherency is both misplaced and incorrect. The nature of detail and preciseness of a program code is irrelevant to whether the code forms a functional characteristic. Furthermore, in order for a reference to *inherently* show a claim element the claim element at issue must *necessarily* be present, not just possibly present or even probably present. *Welter* does not *necessarily* show this connection, so *Welter* does not inherently show it.

The examiner also states that “the point of the individual or user act of signing in the computer device by computer via a password (column 6, lines 25-31) to initiate the

test” shows initiating a search. Signing into a computer does not *necessarily* initiate a search for functional characteristics. A user does not *necessarily* sign in to perform a search. Therefore, *Welter* does not *inherently* show or suggest the features of claim 1.

In addition, the examiner appears to state that an error report, as shown in *Welter* is a functional characteristic. An error report is not a functional characteristic, as claimed, because an error report does not reflect “*the functions supported by the web site that require functions to be enabled by user client devices in order to output the content of the web site on the client device and/or receive input from the client devices directed to the web site.*” Even if an error report could be directed to errors in a functional characteristic, the error report is not *necessarily* a functional characteristic. Thus, *Welter* does not show the features of claim 1. Because *Welter* does not show the features of claim 1, *Welter* does not anticipate claim 1. The remaining claims all contain features relating to functional characteristics. Thus, the remaining claims should be allowable at least for the reasons described above.

In addition, the examiner states that, “since a line of code is a functional characteristic, applicants have admitted the disclosure of the prior art.” This statement is wholly incorrect. As shown above, a line of code is not a functional characteristic even if a line of code might be used to *implement* a functional characteristic. Applicants’ relevant statement appears to be as follows: “*Welter* describes a method for testing HTML code for errors.” This sentence does not concede that *Welter* shows testing functional characteristics. Rather, the sentence states that *Welter* describes a method for testing HTML code for errors. Applicants already stated, and state again, that testing HTML code for errors is not identifying or testing for the presence of “functional characteristics,” as claimed. Accordingly, *Welter* does not anticipate claim 1 or render claim 1 obvious.

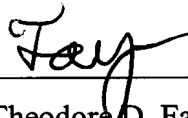
The obviousness rejections all rely on the same flawed interpretation of *Welter*. In view of the fact that *Scarlat* does not cure the lack of disclosure in *Welter* regarding “functional characteristics,” the examiner has failed to state a prima facie obviousness rejection of the claims. Similarly, no suggestion exists in either reference to add these features to the references. Thus, the claims are also non-obvious in view of the references when the references are considered as a whole.

Because the examiner's statements with regard to the meaning of "functional characteristics" are clearly incorrect and because the examiner's characterization of the term vis-à-vis *Welter* and claim 1 is clearly incorrect, a pre-appeal brief review is necessary.

It is respectfully urged that the subject application is patentable over *Welter* and *Scarlat* and is now in condition for allowance. The Pre-Appeal Brief Conference Panel is invited to call the undersigned at the below-listed telephone number if in the opinion of the Panel such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: October 19, 2005

Respectfully submitted,



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